

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID C. WIGGINS

Appeal No. 98-1256
Application 08/599,934¹

ON BRIEF

Before MEISTER, NASE, and CRAWFORD, Administrative Patent Judges.

MEISTER, Administrative Patent Judge.

DECISION ON APPEAL

David C. Wiggins (the appellant) appeals from the final rejection of claims 13-17, 20-26, 28

¹Application for patent filed February 14, 1996.

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and 29. In the paragraph bridging pages 1 and 2 of the amended brief the appellant states

that "no appeal is taken from independent claim 18" (the only other claim remaining in the application) and, accordingly, the appeal of claim 18 is dismissed.²

We AFFIRM-IN-PART.

The appellant's invention pertains to a straight edge guide for cutting flooring materials. Independent claim 13 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the amended brief.

The references relied on by the examiner are:

| | | |
|----------|-----------|---------------|
| Martin | 2,080,620 | May 18, 1937 |
| Nichols | 3,327,360 | Jun. 27, 1967 |
| Loggins | 4,926,564 | May 22, 1990 |
| Anderson | 5,191,716 | Mar. 9, 1993 |

The claims on appeal stand rejected under 35 U.S.C. § 103(a) in the following manner:

(1) Claims 13 and 14 as being unpatentable over Loggins in view of Nichols;

(2) Claims 15-17 as being unpatentable over Loggins in view of Martin;

(3) Claims 20 and 21 as being unpatentable over Loggins in view of Nichols, Anderson and

Martin;

² In the Notice of Appeal (Paper No. 9) claim 18 was included in the appealed claims.

(4) Claims 22, 24, 25 and 28 as being unpatentable over Loggins in view of Nichols and Anderson; and

(5) Claims 23, 26 and 29 as being unpatentable over Loggins in view of Martin and Anderson.

The examiner's rejections are explained on pages 4-10 of the answer. The arguments of the appellant and examiner may be found on pages 4-13 of the amended brief and pages 10-19 of the answer.

OPINION

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the amended brief and by the examiner in the answer. As a consequence of this review, we will sustain the rejections of claims 13-17, 21-26, 28 and 29. We will not, however, sustain the rejection of claim 20.

Initially, we note that in order to establish obviousness under § 103 it is not necessary that the cited references must specifically suggest making the claimed combination. *See, e.g., B.F. Goodrich Co. v. Aircraft Braking Systems Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) and *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988). Instead, the issue of obviousness is not only determined by what the references expressly state but also is deter-

mined by what they would fairly suggest to those of ordinary skill in the art. *See, e.g., In re DeLisle*, 406 F.2d 1386, 1389, 160 USPQ 806, 808-09 (CCPA 1969) and *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969). *See also In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981):

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

We now turn to the specific rejections before us for consideration.

Rejection (1)

With respect to claim 13, the appellant does not appear to contest the examiner's position that it would have been obvious to locate the handle 34a of Loggins on the outrigger 28a (Fig. 1) or 28b (Fig. 2) in view of the teachings of Nichols. Instead, the appellant argues that the limitation of the outrigger not extending from an end of the elongated member cannot be found in either Loggins or Nichols. We are at a loss to understand such a contention. As the examiner has correctly noted on page 4 of the answer, Loggins in the embodiment of Fig. 1 teaches an elongated member 24a and in the embodiment of Fig. 2 an elongated member 24b. In both embodiments the outriggers (28a in the embodiment of

Fig. 1 and 28b in the embodiment of Fig. 2) extend from the respective elongated members at a position intermediate the elongated member's ends and, accordingly, in both embodiments the "outrigger does not extend from an end of said elongated member" as set forth in independent claim 13.

The appellant also makes much of the fact that the devices of Loggins and Nichols are directed to drafting instruments and are not "for cutting flooring materials" as set forth in the preamble of the claims. We must point out, however, that it is well settled that a preamble generally does not limit the scope of a claim if it merely states the invention's purpose or intended use. *See In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994)). While no litmus test can be given with respect to when the introductory words of a claim constitute a statement of purpose for a device or are, in themselves, additional structural limitations of a claim (*see Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)), in a case such as this where elongated member or straight edge 24a or 24b of Loggins clearly has the **capability** of guiding a cutter when cutting flooring materials, we are of the opinion that the above-noted preambular recitation is merely a statement of intended purpose or use which may not be relied on to distinguish structure from the prior art. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997), *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), *In re Yanush*, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973) and *In re Casey*, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). Whether the elongated

member or straight edge 24a or 24b of Loggins actually is or might be used in such a manner merely depends upon the performance or non-performance of a future act of use, rather than a structural distinction in the claims. Stated differently, the elongated member or straight edge 24a or 24b of Loggins would not undergo a metamorphosis to a new device simply because it was used to guide a cutter for flooring materials. *See In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) and *Ex parte Masham*, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987).

With respect to claim 14 the appellant argues that there is no specific disclosure in Loggins which would indicate that the length of the elongated member is "sufficient" to allow a user to place a knee thereon while simultaneously grasping the handle. While it may be true that there is no specific disclosure in Loggins of the size of the elongated member 24a or 24b, artisans must be presumed to know something about the art apart from what the references disclose. *See In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). This being the case, the artisan would understand that drafting instruments (such as those of Loggins) conventionally come in various sizes, and that most of these conventional sizes are sufficiently large to perform the function in question (e.g., if the straight edge of Loggins were 12 inches in length, it would be sufficiently large for a user to place a knee on a portion thereof while at the same time grasping the handle). The artisan would have found it obvious as a matter of common sense (*see In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)) to make the elongated member 24a or 24b of Loggins of such conventional sizes.

In view of the foregoing, we will sustain the rejection of claims 13 and 14 under 35 U.S.C. § 103(a) based on the combined teachings of Loggins and Nichols.

Rejection (2)

The appellant does not appear to dispute the examiner's position that it would have been obvious to attach the riser 32a (and hence the handle 34a) to the elongated member 24a which forms the hypotenuse of Loggins's device in view of the teachings of Martin. Instead, the appellant argues there is no suggestion in the prior art of an outrigger that extends from the elongated member at a position intermediate its ends (as set forth in claim 15) or an elongated member that is sufficiently large for a user to place a knee on a portion thereof while at the same time grasping the handle (as set forth in claim 16). In our view, however, Loggins either teaches or fairly suggests these limitations for the reasons that we have stated above in Rejection (1).

As to claim 17, the appellant broadly argues that the "handle structure of claim 17 is not found in the cited prior art" (brief, page 9). We do not agree. The handles 34a of Loggins (see Fig. 3) and 8 of Martin (see Fig. 2) extend away from their respective risers in *all* directions and, accordingly, can broadly be considered to have an "end" which extends away from the riser and away from the straight edge. Accordingly, we

will sustain the rejection of claims 15-17 under 35 U.S.C.

§ 103(a) based on the combined teachings of Loggins and Martin.

Rejection (3)

With respect to claim 20 the appellant argues that the prior art does not suggest a first riser attached to the outrigger and a second riser attached to the elongated member. We agree. Loggins, Martin and Nichols all have *single* risers. While Anderson teaches two risers, both are connected to an elongated member. There is simply nothing relied on in the prior art which would fairly suggest attaching a first riser to an outrigger and a second riser to an elongated member. This being the case, we will not sustain the rejection of claim 20 under 35 U.S.C.

§ 103(a) based on the combined teachings of Loggins, Nichols, Martin and Anderson.

As to claim 21 the appellant argues there is no suggestion to combine the teachings of the references. We do not agree. First, we observe that in Fig. 1 Loggins discloses an elongated member 22a having a straight edge, an outrigger 28a and a "first" riser 32a which is attached to the elongated member 22a. Thus, we find response in Loggins for all the limitations set forth in claim 21 and conclude that this claim lacks novelty. While we appreciate the fact that the examiner described the rejection in terms of obviousness rather than lack of novelty, we note that lack of novelty is the epitome of obviousness. *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982). Second,

we agree with the examiner that the member 24b of Loggins can also be considered to be the elongated member and that a combined consideration of Loggins and Martin would have fairly suggested that the attachment of the riser along (1) one leg of a triangular-shaped guide (Loggins, Figs. 2 and 3) or (2) the hypotenuse of a triangular-shaped guide (Martin, Fig. 1) are art-recognized alternative which would have been obvious. While the examiner has relied on Nichols for a teaching of attaching the riser to the outrigger and Anderson for a teaching of first and second risers, neither of these limitations appear in claim 21. For the foregoing reasons, we will sustain the rejection of claim 21 under 35 U.S.C. § 103(a) based on the combined teachings of Loggins, Nichols, Martin and Anderson.

Rejection (4)

Initially we note that on page 11 of the brief the appellant argues that claims 22, 24, 25 and 28 "are allowable as depending

from the independent claim 13." We observe, however, that claim 24 depends from claim 18, rather than claim 13.

The appellant argues that Anderson teaches away from the claimed invention since the handle thereof is turned 90° "from the handle of claim 24."³ We must point out, however, that claim 24 merely

³ As to the specific question of "teaching away," our reviewing court in *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) stated:

adds to limitation of claim 18 the provision of the handle having first and second ends with the first end attached to the first riser and the second end extending away from the first riser. This is exactly the arrangement that Anderson teaches in Fig. 3. Illustrated therein is a handle (the horizontal element), a first end (the left-hand end) attached to a first riser (the left-hand riser associated with stud 21) and a second end (the right-hand end) which extends away from the first end. In our view, it would have been obvious to one having ordinary skill in this art to substitute in Loggins for his handle 34a the handle of Anderson in order to achieve Anderson's self-evident advantage of providing for a more secure grip.

It is also the appellant's contention that none of the references teaches a handle rising from an outrigger at an "acute angle, as required by claim 28." However, Anderson in Fig. 3 clearly shows risers extending at acute angles and Nichols shows that it is conventional in the art to provide a handle on an outrigger. Accordingly, a combined consideration of Loggins, Nichols and Anderson would have fairly suggested the subject matter defined by claim 28.

The appellant has not separately argued the patentability of claims 22 and 25 with any reasonable degree of specificity. Accordingly, these claims fall with the claims from which they depend.

A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

Accordingly, even if the appellant was correct in the assertion that the handle of Anderson was oriented in a different direction from that claimed, this fact alone would fall far short of establishing that this reference "teaches away" as the appellant contends.

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In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and 37 CFR § 1.192(c)(7).

In view of the foregoing we will sustain the rejection of claims 22, 24, 25 and 28 under 35 U.S.C. § 103(a) based on the combined teachings of Loggins, Nichols and Anderson.

Rejection (5)

The appellant broadly argues that there is nothing which would suggest attaching the handle of Anderson to a drafting tool (presumably that of Loggins). However, as we have noted above in Rejection (4), we are of the opinion that a combined consideration of Loggins and Anderson would have fairly suggested to the artisan to provide the drafting device of Loggins with a handle as shown by Anderson in Fig. 3 in order to achieve Anderson's self-evident advantage of providing for a better grip. It is also the appellant's contention that there is no suggestion in the references of providing a handle on the outrigger which extends at an acute angle; however, we disagree for the reasons set forth above in Rejection (4) with respect to claim 28.

In summary:

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The rejections of claims 13-17, 21-26, 28 and 29 under 35 U.S.C. § 103(a) are affirmed.

The rejection of claim 20 under 35 U.S.C. § 103(a) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

§ 1.136(a).

AFFIRMED-IN-PART

James M. Meister)
Administrative Patent Judge)
)

Jeffrey V. Nase) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES

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